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10/789,665	02/27/2004	Matthew J. N. C. Roche	FORT-002-002	7553

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EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2168

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03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/789,665	Applicant(s) ROCHE ET AL.	
	Examiner HUNG Q. PHAM	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 20, 21, 23, 24 and 26-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 20, 21, 23, 24, 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/31/2007 has been entered.

Response to Arguments

Claim Rejections - 35 USC § 101

Applicant should amend claims 21, 21, 23 and 24 to overcome the rejection under 35 U.S.C. § 101. The rejection of these claims is continued as in the following manner.

Claim Rejections - 35 USC § 102

Applicant's arguments with respect to the rejection under 35 U.S.C. § 102 have been considered but are moot in view of the new ground(s) of rejection.

Duplicate Claims, Warning

Applicant is advised that should claim 1 be found allowable, claim 34 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20, 21, 23 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20, 21, 23 and 24 recite a computer-readable storage medium. As disclosed in the Specification, the recited computer-readable storage medium includes a stream of information (Paragraph 0081]. The description of paragraph 0024 has provided evidence that applicant intends the medium to include signals, e.g., a stream of information, as such the claimed invention is drawn to a form of energy. Energy is not one of the four categories of invention and therefore claims 1-8 are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore is not a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 34, 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As recited in claim 1, the claimed limitation, *the selected product information includes data that is transmitted to the point of presentation from a server at a third network location in response to the user interaction*, was not described in the specification.

Regarding claim 2, the claimed limitation, *the point of presentation comprises a presentation device at the second network location on which the product is presented*, was not described in the specification.

As recited in claim 34, the claimed limitation, *receiving product data from the presentation device*, was not described in the specification.

As recited in claim 35, the claimed limitation, *presentation medium comprises device executable code that causes said presentation device to transmit said product data to said first network location*, was not described in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 11, 20, 21, 23, 24, 26-28, 30-36 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrington [USP 5,895,454].

Regarding claims 1, 20 and 34, Harrington teaches a method and program for *populating a merchandising product database*, comprising:

obtaining merchandising data related to a product from a point of presentation at a second network location (As shown in FIG. 1, the user 11 is at *a second network location*. User 11 specifies particular criteria, which would be used by the database search engine 21, to obtain a list of vendor web sites that match user 11 product criteria (Col. 4 Lines 12-15). The Harrington teaching indicate the step of *obtaining merchandising data related to a product*, e.g., a list of web sites that match user 11 product criteria, *from a point of presentation*¹, e.g., the database search engine 21),

the obtaining step comprising acquiring selected product information from at least one user interaction at the point of presentation with a presentation medium (User 11 can connect to a vendor web site using

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command. If user 11 activates the purchase button, information relating to the product ordered, the price, availability... is acquired (Col. 4 Lines 15-22 and 35-42). To communicate with database search engine 21, a hierarchical menu is used (Col. 5 Lines 25-47). The Harrington teaching as discussed indicates the step of *acquiring selected product information, e.g., product ordered, the price, availability, from at least one user interaction at the point of presentation, e.g., command to connect to vendor website and purchase command, with a presentation medium, e.g., the hierarchical menu),*

wherein the selected product information includes data that is transmitted to the point of presentation from a server at a third network location in response to the user interaction (As shown in FIG. 1, vendor site 12 is *a server at a third network location*. As discussed above, information relating to the product ordered, the price, availability...from vendor site 12 is sent back to database search engine 21 in response to purchase command (Col. 4 Lines 35-50). The Harrington teaching as discussed indicates the claimed limitation *the selected product information includes data that is transmitted to the point of presentation, e.g., information relating to the product ordered, the price, availability... is sent back to database search engine 21, from a server at a third network location, e.g., vendor site 12, in response to the user interaction, e.g., in response to purchase command);*

storing at least part of the obtained merchandising data in the merchandising product database at the first network location (As shown in FIG. 1, the database 10 is *merchandising product database at the first network location*. As further disclosed by Harrington, information from the vendor including vendor products, locations, website addresses, price, map... is stored in database 10 (Col. 4 Lines 9-15),

the storing comprising collecting the selected product information in the merchandising product database (Col. 7 Lines 1-11).

¹ In light of the specification of the current application, the point of presentation may refer to the output medium of an interactive catalog, e.g., a web page.

Regarding claims 2 and 21, Harrington teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Harrington further discloses *the point of presentation comprises a presentation device at the second network location on which the product is presented* (FIG. 1, a presentation device such as a monitor is an inherited feature of user 11).

Regarding claim 3, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 1, Harrington further discloses *the selected product information comprises data about the product rendered at the point of presentation at the second network location* (Col. 4 Lines 35-50).

Regarding claim 4, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 1, Harrington further discloses the claimed limitation *the merchandising product database does not have information related to the product stored therein prior to the storing step* (Col. 4 Lines 35-50).

Regarding claims 5 and 23, Harrington teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Harrington further discloses *the obtaining step comprises obtaining the merchandising data generally contemporaneously with presentation of the product at the second network location* (Col. 6 Lines 15-24).

Regarding claims 6 and 24, Harrington teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Harrington further discloses *the presentation medium comprises an output medium of an interactive catalog* (Col. 4 Lines 12-15).

Regarding claim 7, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 1, Harrington further discloses *the presentation medium comprises a Web-page* (Col. 4 Lines 12-15).

Regarding claim 8, Harrington teaches a merchandising database system at a first network location (FIG. 1), comprising:

an interface configured to be coupled to a network (The database search engine 21 is *an interface configured to be coupled to a network* (Col. 4 Lines 8-15)) and

to obtain selected product data related to a product presented at a second network location from at least one user interaction at the second network location with a Web-page served by a server at a third network location (User 11 specifies particular criteria, which would be used by the database search engine 21, to obtain a list of vendor web sites that match user 11 product criteria (Col. 4 Lines 12-15). User 11 interacts with the remote vendor website using the commands (Col. 4 Lines 18-22). If user 11 activates the purchase button, information relating to the product ordered, the price, availability... is acquired and sent back to database search engine 21. (Col. 4 Lines 15-22 and 35-46). The database search engine provides a realtime total or cost, goods ordered... to user 11 (Col. 4 Lines 46-48). The Harrington teaching indicates the purpose of database search engine 21 is *to obtain selected product data related to a product, e.g., information relating to the product ordered, the price, availability..., presented at a second network location, e.g., realtime total or cost, goods ordered... are provided to user 11, from at least one user interaction at the second network location, e.g., selecting purchase, with a Web-page served by a server at a third network location, e.g., the remote vendor website served by vendor),*

wherein the selected product data includes data that is transmitted to the second network location from the server at the third network location in response to the user interaction (As shown in FIG. 1, vendor site

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12 is *a server at a third network location*. As discussed above, information relating to the product ordered, the price, availability...from vendor site 12 is sent back to database search engine 21 in response to purchase command (Col. 4 Lines 35-50). The Harrington teaching as discussed indicates the claimed limitation *the selected product information includes data that is transmitted to the point of presentation*, e.g., information relating to the product ordered, the price, availability... is sent back to database search engine 21, *from a server at a third network location*, e.g., vendor site 12, *in response to the user interaction*, e.g., in response to purchase command; and

a storage device configured to store at least part of the selected product data at the first network location (FIG. 1 and Col. 7 Lines 1-11).

Regarding claim 9, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 8, Harrington further discloses *the interface is configured to obtain the selected product data directly from a presentation device on which the Web-page is presented at the second network location* (Col. 4 Lines 35-50).

Regarding claim 11, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 9, Harrington further discloses *the interface is configured to obtain the selected product data generally contemporaneously with presentation of the Web-page* (Col. 6 Lines 15-24).

Regarding claim 26, Harrington teaches a method for populating a merchandising product database located at a first network location, comprising:

rendering in response to user interaction with an interactive catalog, at least a portion of the interactive catalog at a second network location (A hierarchical menu is displayed for querying (Col. 5 Lines 25-47). A list of vendor websites is provided according to the query and the user is connected to a selected vendor website using command (Col. 4 Lines 12-22). The Harrington teaching

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indicates the step of *rendering in response to user interaction with an interactive catalog*, e.g., in response to user interaction with the hierarchical menu, *at least a portion of the interactive catalog at a second network location*, e.g., the selected vendor website is rendered at the user site),

wherein content of the rendered portion includes selected data related to one or more products displayed by the rendered portion of the interactive catalog (The content of the selected vendor website includes selected data related to the product displayed at the selected vendor website, e.g., information related to product ordered, the price, availability... (Col. 4 Lines 23-50)), and

wherein the content is obtained by the second network location from one or more source product databases at a third network location in response to the user interaction with the interactive catalog (As discussed above, the content of the selected vendor web site is obtained by the user from the vendor site in response to user interaction with the hierarchical menu);

communicating the selected data related to the products from the second network to the merchandising product database at the first network location such that the selected data is communicated from the source product databases to the merchandising product database by way of the second network location in response to the user interaction and without requiring a direct data transfer between the source product databases at the third network location and the merchandising product database at the first network location (Col. 4 Lines 35-50 and Col. 7 Lines 1-11); and

modifying the merchandising product databases using the selected data such that the databases include a representation of the selected data (Col. 7 Lines 1-11).

Regarding claim 27, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 26, Harrington further discloses *information from the source product databases is communicated to the merchandising product database through the interactive catalog* (Col. 5 Lines 25-47 and Col. 4 Lines 12-22).

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Regarding claim 28, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 26, Harrington further discloses *the selected data comprises parameters embedded within the rendered portion of the interactive catalog* (Col. 4 Lines 35-50).

Regarding claim 30, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 26, Harrington further discloses *the selected data comprises a product description* (Col. 4 Lines 35-50).

Regarding claims 31-33, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 1, 8 and 20, Harrington further discloses *the selected information comprises portions of the presentation medium specified by the third network location for storage at the merchandising database at the first network location* (Col. 4 Lines 35-50).

Regarding claim 35, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 34, Harrington further discloses *presentation medium comprises device executable code that causes said presentation device to transmit said product data to said first network location* (Col. 4 Lines 35-50).

Regarding claim 36, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 35, Harrington further discloses *presentation medium comprises a Web page* (Col. 4 Lines 35-50).

Regarding claim 38, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 36, Harrington further discloses *product data comprises a product description* (Col. 4 Lines 35-50).

Regarding claim 39, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 36, Harrington further discloses *product data comprises parameters specified by said third network location for storage at said merchandising product database at said first network location* (Col. 4 Lines 35-50).

Regarding claim 40, Harrington teaches all of the claimed subject matter as discussed above with respect to claim 39, Harrington further discloses the step of *storing said parameters in said merchandising product database contemporaneously with said user action* (Col. 4 Lines 35-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 29 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington [USP 5,895,454] in view of Musgrove et al. [USP 6,535,880 B1].

Regarding claims 29 and 37, Harrington teaches all of the claimed subject matter as discussed above with respect to claims 26 and 36, but does not explicitly teach *the selected data comprises a product identification*.

Musgrove teaches *the selected data comprises a product identification* (Musgrove, Col. 7 Lines 1-5).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include product identification in the selected data in order to keep track the product orders.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HUNG Q PHAM/
Primary Examiner
Art Unit 2168

March 21, 2008